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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SANDRO DAVID KLEIN and PATRICK H. HAYES

Appeal 2009-014056
Application 10/694,582
Technology Center 2600

Before JEFFREY S. SMITH, JASON V. MORGAN, and ERIC B. CHEN,
Administrative Patent Judges.

CHEN, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-28 and 30-50. Claim 29 has been cancelled. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

Appellants' invention relates to a controlling device having a feature for toggling between various device mode states (e.g., TV, VCR or cable (Spec. 1:23-25)). (Abstract.)

Claims 1 and 46 is exemplary, with disputed limitations in *italics*:

1. A controlling device having a plurality of device mode states each of which is selectable to configure the controlling device to command operating functions of one or more of a plurality of different appliances defined for that device mode state, the controlling device comprising:

programming responsive to receipt of a first input for directly selecting one of the plurality of device mode states to thereby configure the controlling device; and

programming responsive to receipt of a second input for selecting, as a function of at least one of a one of the plurality of device mode states the controlling device is in at a time the second input is received and a one of the plurality of device mode states the controlling device was placed into a last time the second input was received one of a subset of the plurality of device mode states to thereby configure the controlling device.

46. For use in a controlling device having a plurality of device mode states each of which may be selected to configure the controlling device to transmit command codes to one or more of a plurality of different appliances, a method comprising:

receiving input for causing the controlling device to change from a first device mode state selected from the plurality of device mode states to a second device mode state selected from the plurality of device mode states; and

in response to the input being received placing the controlling device into the second device mode state and storing data indicative of the first device mode state in the controlling device whereby the

stored data is used by the controlling device in connection with an actuation of a device mode state toggle key of the controlling device to return the controlling device to the first device mode state.

Claims 1-7, 10-12, 14, 17-20, 23-28, 30-36, 38 and 41-45 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Van Ryzin (U.S. Patent No. 6,127,941, Oct. 3, 2000).¹

Claims 46-48 and 50 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lin (U.S. Patent No. 6,633,281 B2, Oct. 14, 2003).

Claims 8 and 9 stand rejected under 35 U.S.C. § 103(a) as being obvious over Van Ryzin and Lin.

Claims 13 and 37 stand rejected under 35 U.S.C. § 103(a) as being obvious over Van Ryzin and Tigwell (U.S. Patent No. 5,227,780, Jul. 13, 1993).

Claims 15, 16, 39 and 40 stand rejected under 35 U.S.C. § 103(a) as being obvious over Van Ryzin and Hashimoto (U.S. Patent No. 5,554,980, Sep. 10, 1996).

Claims 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being obvious over Van Ryzin and Griesau (U.S. Patent No. 6,507,306 B1, Jan. 14, 2003).

Claim 49 stands rejected under 35 U.S.C. § 103(a) as being obvious over Lin and Tigwell.

¹ Appellants have erroneously omitted claims 23 and 25 from the statement of the rejection. (App. Br. 5.)

ANALYSIS

§ 102 Rejection – Van Ryzin

We are persuaded by Appellants’ arguments (App. Br. 6-9; *see also* Reply Br. 2-4) that Van Ryzin does not disclose the disputed limitation “programming responsive to receipt of a second input for selecting, as a function of at least one of a one of the plurality of device mode states the controlling device is in at a time the second input is received,” as recited in independent claim 1.

The Examiner found that the television set (TV) 120, the 200 CD and the AM/FM receiver 130 of Van Ryzin corresponds to the claimed “plurality of device mode states.” (Ans. 4.) The Examiner also found that the user selection of the TV 120 from a pull-down menu on the display 104 for adjusting volume or channel corresponds to the claimed “second input for selecting.” (Ans. 4.) We do not agree.

Van Ryzin relates to “[a] two-way remote control unit with a graphical user interface [that] controls various audio/video devices interconnected in a multimedia system.” (Abstract.) Figure 1A of Van Ryzin illustrates a remote control unit 100 with a display 104 (col. 3, ll. 42-43) for issuing commands to a multimedia system, including a television set (TV) 120, a 200 CD changer 122, a DVD device 124, a DAT device 126, a VCR 128 and an AM/FM receiver 130 (i.e., the claimed “plurality of device mode states”) (col. 4, ll. 26-28). In one example, “if the user selects the TV 120, then a pull-down menu appears on the display 104 with the following functions ‘increase volume’, ‘decrease volume’, ‘increase channel by 1’, ‘decrease channel by 1’ . . .” (Col. 5, ll. 44-47.)

Claim 1 recites “a second input for selecting . . . at least one of a one of the *plurality of device mode states* the controlling device is in at a time the second input is received and a one of the *plurality of device mode states* the controlling device was placed into a last time the second input was received one of a subset of the *plurality of device mode states*” (emphasis added). In other words, the claimed “second input” is required to select from between: (i) “one of the plurality of device mode states” currently selected; and (ii) “one of the plurality of device mode states” selected just prior to the current selection. Thus, when the user of Van Ryzin selects the TV 120 from the pull-down menu that appears on the display 104 to increase or decrease the volume or channel, the user is not selecting from between: (i) the current selection of the TV 120; and (ii) the previous selection from one of the multimedia devices (e.g., the 200 CD changer 122, the DVD device 124, the DAT device 126, the VCR 128 or the AM/FM receiver 130).

Therefore, we do not agree with the Examiner that Van Ryzin describes the limitation “programming responsive to receipt of a second input for selecting, as a function of at least one of a one of the plurality of device mode states the controlling device is in at a time the second input is received.”

Accordingly, we do not sustain the rejection of independent claim 1 under 35 U.S.C. § 102(b). Claims 2-7, 10-12, 14, 17-20, 23 and 24 depend from independent claim 1. We do not sustain the rejection of claims 2-7, 10-12, 14, 17-20, 23 and 24 under 35 U.S.C. § 102(b) for the same reasons discussed with respect to independent claim 1.

Independent claim 25 recites limitations similar to those discussed with respect to independent claim 1. We do not sustain the rejection of

claim 25, as well as claims 26-28, 30-36, 38 and 41-45, which depend from claim 25, for the same reasons discussed with respect to claim 1.

§ 102 Rejection – Lin

We are persuaded by Appellants' arguments (App. Br. 9-10; *see also* Reply Br. 4-5) that Lin does not disclose the disputed limitation "in response to the input being received placing the controlling device into the second device mode state and storing data indicative of the first device mode state . . . whereby the stored data is used by the controlling device in connection with an actuation of a device mode state toggle key of the controlling device to return the controlling device to the first device mode state," as recited in independent claim 46.

The Examiner found that the selection of the TV item on the touch-type screen 11 of Lin corresponds to the claim limitation "receiving input for causing the controlling device to change from a first device mode state selected from the plurality of device mode states to a second device mode state." (Ans. 8.) The Examiner also found that the macro button (M) of Lin correspond to the claimed "device mode state toggle key of the controlling device." (Ans. 8, 12.) We do not agree.

Lin relates to "a universal remote control and, more particularly, to an intelligent touch-type universal remote control . . ." (Col. 1, ll. 7-9.) Figure 1 of Lin illustrates an intelligent touch-type universal remote control including a touch-type screen 11 (col. 4, ll. 3-7) for controlling electrical appliances such as a TV, an LD/VCD player, a DVD player, a VCR, an amplifier (AMP) or a CD player (col. 4, ll. 21-26). In one example, the TV item of the touch-type screen 11 is pressed to control the TV. (Col. 4, ll. 29-31.) Figure 4 of Lin illustrates the touch-type screen 11 with a macro (M)

button (col. 4, ll. 60-63) that executes a series of operations corresponding to multiple buttons (col. 4, l. 66 to col. 5, l. 2) (e.g., powering on a TV, selecting a channel for a VCR, powering on the VCR, and pressing a play button (col. 2, ll. 13-20)). However, there is no express disclosure in Lin that the macro button (M) functions as a “device mode state toggle key” between a TV, an LD/VCD player, a DVD player, a VCR, an amplifier (AMP) and a CD player.

Therefore, we do not agree with the Examiner that Lin describes the limitation “in response to the input being received placing the controlling device into the second device mode state and storing data indicative of the first device mode state . . . whereby the stored data is used by the controlling device in connection with an actuation of a device mode state toggle key of the controlling device to return the controlling device to the first device mode state.”

Accordingly, we do not sustain the rejection of independent claim 46 under 35 U.S.C. § 102(b). Claims 47 and 48 depend from independent claim 46. We do not sustain the rejection of claims 47 and 48 under 35 U.S.C. § 102(b) for the same reasons discussed with respect to independent claim 46.

Independent claim 50 recites limitations similar to those discussed with respect to independent claim 46. We do not sustain the rejection of claim 50 for the same reasons discussed with respect to claim 46.

§ 103 Rejection – Van Ryzin and Lin

Lin was cited by the Examiner for teaching the additional features of dependent claims 8 and 9. (Ans. 9.) However, the Examiner’s application of Lin does not cure the above noted deficiencies of Van Ryzin. Therefore,

we do not sustain the rejection of claims 8 and 9 for the same reasons discussed with respect to independent claim 1.

§ 103 Rejection – Van Ryzin and Tigwell

Tigwell was cited by the Examiner for teaching the additional features of dependent claims 13 and 37. (Ans. 9-10.) However, the Examiner's application of Tigwell does not cure the above noted deficiencies of Van Ryzin. Therefore, we do not sustain the rejection of claims 13 and 37 for the same reasons discussed with respect to independent claims 1 and 25.

§ 103 Rejection – Van Ryzin and Hashimoto

Hashimoto was cited by the Examiner for teaching the additional features of dependent claims 15, 16, 39 and 40. (Ans. 10.) However, the Examiner's application of Hashimoto does not cure the above noted deficiencies of Van Ryzin. Therefore, we do not sustain the rejection of claims 15, 16, 39 and 40 for the same reasons discussed with respect to independent claims 1 and 25.

§ 103 Rejection – Van Ryzin and Griesau

Griesau was cited by the Examiner for teaching the additional features of dependent claims 21 and 22. (Ans. 10-11.) However, the Examiner's application of Griesau does not cure the above noted deficiencies of Van Ryzin. Therefore, we do not sustain the rejection of claims 21 and 22 for the same reasons discussed with respect to independent claim 1.

§ 103 Rejection – Lin and Tigwell

Tigwell was cited by the Examiner for teaching the additional features of dependent claim 49. (Ans. 11.) However, the Examiner's application of Tigwell does not cure the above noted deficiencies of Lin. Therefore, we do

not sustain the rejection of claim 49 for the same reasons discussed with respect to independent claim 46.

DECISION

The Examiner's decision to reject claims 1-28 and 30-50 is reversed.

REVERSED

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